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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,587	03/29/2004	Osamu Nakamura	042234	9493
38834 7590 12/11/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER NAKARANI, DHIRAJLAL S	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication. .

Office Action Summary

Application No.

10/810,587

Applicant(s)

NAKAMURA ET AL.

Examiner

D. S. Nakarani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7,10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 20, 2007 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The amendment filed January 24, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Lines 4-5 of the amended paragraph beginning page 13, line 8, the phrase "a copolymer with (meth)acrylic amide and a monomer copolymerizable therewith" is a new matter because the specification as originally filed fail to provide support for monomer copolymerizable with (meth)acrylic amide. Applicants have not pointed-out where the support for the added subject matter can be found in the originally filed specification. In addition, the phrase "polymer of (meth)acrylic ethyl ester ----- ammonium salts of (meth)acrylic acid" is unclear and cannot be understood. It is not clear whether

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applicants are trying to claim homopolymer of recited monomers or copolymer of (meth)acrylic acid with recited monomers. Clarification and/or correction requested.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. Claims 1, 5, 7, 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fail to provide support for the claimed polymer (1) polymer of (meth)acrylic ethyl ester, (2) polymer of (meth)acrylic butyl ester, (3) a copolymer with (meth)acrylic amide and a monomer copolymerizable therewith, (4) polymer of alkali metal salt of (meth)acrylic acid and (5) polymer of ammonium salt of (meth)acrylic acid as (meth)acrylic acid polymer (b2). The specification as originally filed defines the term "the (meth)acrylic acid polymer (b2)" is meant herein polymers predominantly containing acrylic acid and/or methacrylic acid (Page 13, lines 8-9 of the present specification). The claimed polymer (1) polymer of (meth)acrylic ethyl ester reads on homopolymer of (meth)acrylic ethyl ester monomer, and (2) polymer of (meth)acrylic butyl ester reads on homopolymer of (meth)acrylic butyl ester monomer. The originally filed specification does not provide support for these homopolymers. The originally filed specification does not support a copolymer with (meth)acrylic amide and a unspecified monomer copolymerizable therewith. The originally filed specification may

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provide support for copolymer of (meth)acrylic acid with (meth)acrylic amide wherein the (meth)acrylic acid monomer is a major component (i.e. predominant component).

Both, claimed polymer of alkali metal salt of (meth)acrylic acid and polymer of ammonium salt of (meth)acrylic acid reads on 100% neutralized (meth)acrylic acid polymers which are not supported by originally filed specification. The originally filed specification provides support for a partially neutralized (meth)acrylic acid polymer (Page 13, lines 24-25). There is nothing on record showing that applicants had possession of the inventions with afore mentioned polymers (1) to (5).

5. Claims 1, 5, 7, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 16-20, the markush group members "polymer of (meth)acrylic ethyl ester", "polymer of (meth)acrylic butyl ester", "a copolymer with (meth)acrylic amide and a monomer copolymerizable therewith", "polymer of alkali metal salt of (meth)acrylic acid" and "polymer of ammonium salt of (meth)acrylic acid" renders claims indefinite and confusing because as per the phrase "the (meth)acrylic acid polymer (b2) contains predominantly acrylic acid and/or methacrylic acid and" before the markush group requires polymers recited in the markush group to contain predominantly acrylic and/or methacrylic acid while afore said markush group members does not require to contain any amount of acrylic acid and/or methacrylic acid. Therefore claims are indefinite and confusing. In addition, lines 13-14, the phrase "the (meth)acrylic acid polymer (b2)

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contains predominantly acrylic acid and/or methacrylic acid” and lines 21-22, the phrase “wherein if (meth)acrylic acid polymer (b2) contains a carboxylic acid group, said (meth)acrylic acid polymer (b2) has a degree of neutralization of 3-15%” renders claims indefinite.

6. Applicant's arguments filed August 20, 2007 have been fully considered but they are not persuasive. In reference to objection to the amendment filed January 24, 2007 as the phrase “a copolymer with (meth)acrylic amide and a monomer copolymerizable therewith” introducing new matter, applicants mainly argue that since a copolymer is defined as a polymer of two distinct monomers, and since only a single monomer was originally stated, one skilled in the art would have immediately known that the term “a copolymer with (meth)acrylic amide” necessarily means “a copolymer between (meth)acrylic amide and another monomer copolymerizable with (meth)acrylic amide.

These arguments are unpersuasive because as per definition of the term “the (meth)acrylic acid polymer (b2) is meant herein polymers predominantly containing acrylic acid and/or methacrylic acid”. Therefore the copolymers other than the copolymer of (meth)acrylic amide and (meth)acrylic acid is a new matter. Likewise any polymer (or copolymer) does not contain predominant amount of acrylic acid and/or methacrylic acid is also a new matter.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S. Nakarani/
D. S. Nakarani
Primary Examiner
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DSN
December 4, 2007.